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the specification, for example, at page 11, lines 10-15. No new matter has been added. Should the Examiner determine that claim 10 is drawn to a separate, patentably distinct invention, and require restriction, then Applicants respectfully request that claim 8 not be treated as having been constructively elected. Instead, Applicants respectfully request that the Examiner issue a written restriction requirement and provide Applicants an opportunity to make an election.

Regarding the amendment to claim 8, a clean copy of claim 8 is presented above. A mark-up showing the changes that have been made to claim 8 using brackets and underlining is attached.

For the record, Applicants emphasize that although claim 8 was amended, and, therefore, might be argued to have been amended for a reason substantially related to patentability, a fair reading of the amended claim 8 will reveal that the departures from the previous claim 8 were for clarification purposes only, and that Applicants did not narrow the claim in any material respect. Therefore, Applicants submit that the amended claim remains entitled to the full range of equivalents.

The sole substantive issue for consideration is the rejection of claims 2-9 under 35 USC § 103(a) as being obvious over Matsumura et al. ("Matsumura"), unidentified, but, apparently, *J. Jap. Oil. Chem. Soc.*, 40: 709-714 (1991), or *J. Am. Oil Chem. Soc.*, 67: 996-1001 (1990), Shoji et al. ("Shoji"), U.S. Patent No. 5,459,257, or Ikekawa et al. ("Ikekawa"), *Chem. Pharm. Bull.*, 35: 2894-2899 (1987), in view of Ziolkowsky, *SOFW*

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J., 121: 973-4, 976 and 979 (1995). In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The Examiner concedes that Matsumura, Shoji and Ikekawa do not teach the employment of Applicants' active ingredients dermally or cosmetically. Indeed, whereas the present claims require that Applicants' active ingredients be topically applied to "skin, hair and/or nails," there does not appear to be any teaching of such topical applications to these particular body areas in any of the cited primary references.

In order to overcome these clear deficiencies of these primary references, the Examiner relies on Ziolkowsky, which, according to the Examiner "teaches the claimed compounds as useful for a dermal, cosmetic use." According to the Examiner, "[p]ossessing this teaching, the skilled artisan would have been motivated to employ the claimed compounds for the dermal, or cosmetic use herein claimed and enjoy a reasonable expectation of therapeutic success."

In response, Applicants submit again that this combination of references does not make out a *prima facie* case. Where, as here, the claimed subject matter has been rejected over a combination of prior art references, a *prima facie* case of obviousness is only made out where the prior art would have (1) suggested to those of ordinary skill in the art that they should carry out the claimed process and also (2) revealed to those of ordinary skilled in the art that in so carrying out the claimed process, those of ordinary skill in the art would have had a reasonable expectation of success. *See, for example, In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Applicants submit that both the

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suggestion and the reasonable expectation of success are lacking here, the Examiner's statements notwithstanding.

While Ziolkowsky may have applied similar compounds to hair, there is not the slightest indication in the abstract upon which the Examiner relies that such application has been for the purpose of combating bacteria, fungi and/or viruses, as presently claimed. Consequently, the combination of Ziolkowsky and the primary references still leaves persons skilled in the art without a reasonable expectation that application of the substances of the primary references to hair to combat bacteria, fungi and/or viruses therein would have been successful. The fact that Ziolkowsky might have applied similar compounds to hair does not mean that all activities of such compounds could have been realized on hair.

Further, without a suggestion in these references that bacteria, fungi and/or viruses could be topically combated with the instant compounds with a reasonable expectation of success, persons skilled in the art would not have been motivated to determine proper administration levels for topical applications.

It is unclear whether the Examiner was giving weight to the preamble of claim 8 that the method was for "combating bacteria, fungi and/or viruses." However, Applicants have amended the body of claim 8 to make clear that the result of the method is the achievement "an inhibition of a growth of at least one bacterium, fungus and/or virus as a result of said topically applying." There is absolutely no teaching or suggestion in the cited combination of references, as noted above, that topical application of Applicants'

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active ingredients would have resulted in the inhibition of the growth of at least one bacterium, fungus and/or virus, as claimed. Consequently, the instant claims would not have been *prima facie* obvious from the cited combination of references.

Respectfully, this combination of cited references does not make out a case that the claimed invention would have been *prima facie* obvious. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Preliminary Amendment and Mark-up Showing Changes Made to Claims (7 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: May 1, 2002

By

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**MARK-UP SHOWING THE CHANGES MADE IN THE PREVIOUS CLAIM TO
YIELD THE CLAIM AS AMENDED ABOVE**

--8. (Once Amended) [Method] A method of combating bacteria, fungi and/or viruses, said method comprising topically applying to skin, hair and/or nails an effective amount therefor of an alkylated and/or acylated monosaccharide and/or oligosaccharide and achieving an inhibition of a growth of at least one bacterium, fungus and/or virus as a result of said topically applying. --